

Remarks

Claims 1-26 are pending in the application.

Rejection of Claims 1-8, 14-21, and 25-26 under 35 U.S.C. 102(b)

In section 2 of the Office Action dated January 13, 2006, the Examiner has rejected claims 1-8, 14-21, and 25-26 under 35 U.S.C. 102(b) as being anticipated by Nokia 7210 User Guide, Internet Article 2003, pages 39-50, XP002316253.

The concept of the instant application relates to a system and method wherein a handheld electronic device is capable of automatically selecting, in response to a first set of data elements, a data format for use with a second set of data elements. This is advantageous because the user can continue to enter data into the handheld electronic device without having to format the second set of data elements.

To illustrate, if the handheld electronic device detects that the user has entered "Pennsylvania" or an abbreviation thereof (i.e. "PA") into the device, the device will automatically format the zip code (postal code) field to correspond to a United States Zip Code (5 numeric characters or 5 numeric characters plus an additional 4 numeric characters separated by a hyphen). If the handheld electronic device detects that the user has entered "Ontario", which is a Canadian province, or an abbreviation thereof (i.e. "ON") into the device, the device will automatically format the postal code field to correspond to a Canadian postal code (6 alternating alphabetic and numeric characters with a space dividing the third and fourth characters).

In contrast, the Nokia reference is directed towards a cellular telephone in which a user can store telephone numbers and text. See page 45, item 5. Specifically, Nokia is at most directed towards a system wherein a user can select a particular numeric field from among a plurality of numeric fields into which numeric input will be entered, and wherein the user can select a particular text field from among a

plurality of text fields into which textual input will be entered. For instance, Nokia discloses that the user can select either a "number type" (i.e. General, Mobile, Home, Office, and Fax) or a "text type" (E-mail address, Web address, Postal Address, and Note). See page 45, item 5. Nokia further indicates that the user can change the number or text type by selecting "change type" and entering the desired number or text. See page 45, items 5 and 6.

Nokia does not disclose a handheld electronic device that automatically selects, in response to a first set of data elements processed from a first input, a data format for use with a second set of data elements, as is recited in claims 1 and 18. Moreover, Nokia does not disclose a handheld electronic device that detects a second input and processes the detected second input to obtain a second set of data elements which are automatically formatted to conform with the selected data format, as is also recited in Claim 1 and 18.

With regards to claims 2-3 and 19, Nokia does not disclose obtaining as the first character or as a plurality of characters of the second set of data elements either a numeric or alphabetic character according to a selected corresponding data format since Nokia does not disclose formatting of data according to a selected data format.

With regards to claims 4-5 and 20, Nokia does not disclose comparing the first input with a data set, which includes a plurality of data records in memory, and identifying one of the records to obtain the first set of data elements. Rather, Nokia on page 45, paragraph 2, item 2, lines 1-4, is merely describing that a user can scroll through a phone book that is stored on the device. Additionally, Nokia is unclear as to what occurs in response to entering the first characters of the name that is to be searched.

With regards to claims 7-8 and 21, Nokia does not disclose detecting a number of key inputs, processing each of the key inputs to obtain a number of processed key outputs that conform to the selected data format, and outputting each one of the processed key outputs to correspond with one of the detected key inputs since Nokia does not disclose formatting data according to a selected data format which is selected in response to a first set of data elements.

With regards to claims 14 and 25, Nokia does not disclose employing as the first input one of a country input and a sub-country input. Rather, Nokia at most describes that the device is capable of storing a postal address.

With regards to claims 15 and 26, Nokia does not disclose determining that the first input is a sub-country input, comparing the first input with a data set that includes a plurality of country data records stored in memory, and identifying one of the country data records to obtain the first set of data elements. As stated in the preceding paragraph, Nokia at most describes a device that is capable of storing a postal address. Moreover, Nokia does not disclose whether the device is capable of making any type of comparisons.

With regards to claim 16, Nokia does not disclose detecting as the sub-country input one of a Canadian province and an American state and obtaining as the first set of data elements a representation of Canada and America, respectively. As stated above, the device in Nokia only stores a postal address. Nokia does not disclose a device that is capable of detecting a sub-country code and in response to the sub-country code entering a country code as the first set of data elements.

Because Nokia fails to disclose all of the elements of independent claims 1 and 18, the Applicant respectfully submits that the rejection of claims 1 and 18, as well as claims 2-8, 14-17, 19-21, and 25-26 which depend directly or indirectly from

them, on the ground of anticipation has been successfully overcome. Accordingly, withdrawal of the rejection is respectfully requested.

Rejection of Claims 9-12 and 22-23 under 35 U.S.C. 103(a)

In section 4 of the Office Action, the Examiner rejected claims 9-12 and 22-23 under 35 U.S.C. 103(a) as being unpatentable over Nokia in view of Applicant's Background.

As stated elsewhere herein, Nokia does not disclose every element recited in claims 1 and 18, which are submitted to be allowable. Claims 9-12 and 22-23 depend either directly or indirectly from claims 1 and 18. Accordingly, Applicant submits that these claims are also allowable.

In the Background Section of the present application, Applicant clearly states that handheld electronic devices have keys that perform multiple functions under certain conditions. For instance, a given key, when pressed, may input a lower case letter or a capital letter when combined with a <SHIFT> key. Furthermore, the Applicant states that the key may also input a digit or symbol when the key is combined with an <ALT> key. Pg. 1, lines 16-22.

In contrast, claims 9-12 and 22-23 recite that the handheld electronic device outputs at least one processed output. The processed output, for instance, is an output that was automatically formatted to correspond to a selected data format.

Therefore, Nokia and the portions of the instant application contended by the Examiner to be "Applicant's Admitted Prior Art" do not teach, suggest, or disclose every element recited in Applicant's claims 9-12 and 22-23 since they do not, alone or in combination, disclose a method or a system in which the handheld electronic device is capable of automatically selecting, in response to a first set of data elements, a data format for use with a second set of data elements, wherein the second set of

data elements conform to the selected corresponding data format. Accordingly, withdrawal of the rejection under 35 U.S.C. § 103(a) is respectfully requested.

Rejection of Claim 17 under 35 U.S.C. 103(a)

In section 5 of the office action, the Examiner has rejected claim 17 as being unpatentable over Nokia in view of Rayani.

As stated elsewhere herein, Nokia does not disclose every element recited in claim 1. Claim 17 indirectly depends from claim 1. Moreover, the Examiner acknowledges that Nokia does not teach selecting a first corresponding data format that corresponds with a country's postal code.

Unlike the concept of the instant application, Rayani describes a process for entering an address into a system where the system prompts the user for a first part of an address, and based on the information entered for the first part of the address the system generates a list of selectable options for a second part of the address from which the user must select. See paragraphs [0028] - [0030] and FIG. 18.

Rayani does not disclose formatting a second set of data elements to conform with a data format that was automatically selected in response to a first set of data elements.

There are a variety of drawbacks to the system disclosed in Rayani. For instance, the system would have to be periodically updated to ensure that the most current zip codes are loaded onto the system. Additionally, the zip codes would have to be stored on the system thereby occupying system memory. Furthermore, there is also a possibility that some zip codes might not be available to a user if the information is not loaded onto the system.

Moreover, it is well settled that to establish a prima case of obviousness, one must show "some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teaching of the references." Tec Air, Inc. v. Denso Manufacturing Michigan Inc., 192 F.3d 1353, 1359-1360 (Fed. Cir. 1999), *quoting* In re Fine, 837 F.2d 1071, 1074 (Fed. Cir. 1988). There is, however, "no suggestion to combine...if a reference teaches away from its combination with another reference." Id. At 1360. A reference teaches away from an invention "when a person of ordinary skill...would be led in a direction divergent from the path that was taken by the applicant." Tec Air, 192 F.3d at 1360 (Fed. Cir. 1999), *quoting* In re Gurley, 27 F.2d 551, 553 (Fed. Cir. 1994). As stated above, Rayani teaches a process for entering an address into a system where the system prompts the user for a first part of an address, and based on the information entered for the first part of the address the system generates a selectable list of options for a second part of the address. As a result, Rayani clearly leads "in a direction divergent from the path that was taken by" the Applicant by teaching a system that requires the user to select the second part of the address from the generated list. Accordingly, it is not proper to use Rayani to reject Applicant's claims 1, 11, 20, and 21 under 35 U.S.C. §103(a) and Applicant respectfully requests withdrawal of the rejection under 35 U.S.C. § 103(a).

Rejection of Claims 13 and 24 under 35 U.S.C. §103(a)

In section 6 of the Office Action, the Examiner has rejected claims 13 and 24 under 35 U.S.C. 103(a) as being unpatentable over Nokia in view of Coutre.

As stated elsewhere herein, Nokia does not disclose every element recited in claims 1 and 18. Claim 13 directly depends from claim 1 and claim 24 directly

depends from claim 18. Accordingly, Applicant submits that claims 13 and 24 are also allowable.

In general, col. 10, lines 29-35, of Coutre is directed towards alerting a user if data was not entered into the system correctly. Specifically, the system checks to see whether the data has been entered correctly only after all of the data was supposedly entered into the system. See col. 10, lines 29-31. Accordingly, the system that is described in col. 10, lines 29-35, would not prompt the user for missing data until the end of the data entering process.

In contrast, claims 13 and 24 recite that upon detecting an initiation of the second input, the handheld electronic device will display a prompt if the handheld electronic device has yet to detect the first input. Therefore, unlike the system described in Coutre the handheld electronic device of the present application, as recited in claims 13 and 24, does not wait until the end of the data entering process to display a prompt instructing the user to enter the first input.

Neither the Nokia reference nor Coutre discloses every limitation recited in claims 1 and 18 from which claims 13 and 24 directly depend. Accordingly, the Applicant submit that claims 13 and 24 are in condition for allowance and withdrawal of the rejection under 35 U.S.C. 103(a) is requested.

Conclusion

In light of the foregoing arguments, it is respectfully submitted that claims 1-26 are in proper form for issuance of a Notice of Allowance and such action is respectfully requested at an early date.

In the event that any outstanding matters remain with this application, Examiner is invited to telephone the undersigned at 412-566-1920 to discuss such matters.

Respectfully submitted,



Robert A. Diaz
Attorney for Applicant
Eckert Seamans Cherin &
Mellott, LLC
600 Grant Street, 44th Floor
Pittsburgh, PA 15219